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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :  
Burkhard STANDKE, et al. : GROUP ART UNIT: 1712  
SERIAL NO.: 09/987,268 :  
FILED: NOVEMBER 14, 2001 : EXAMINER: ZIMMER  
FOR: N-PROPYLETHOXYSILOXANES, THEIR PREPARATION AND USE

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

In response to the Official Action dated November 20, 2003, Applicants elect, with traverse, Group I, Claims 1-14, 16, 27-35. With the election of Group I an Election of Species is not required.

REMARKS

The Office has restricted this application as follows under 35 U.S.C. §121:

- Group I: Claims 1-14, 16, 27-35, drawn to an oligomeric mixture;
- Group II: Claim 15, drawn to a method of making an oligomeric mixture;
- Group III: Claims 17-22, 24 and 36-40, drawn to a method of coating/treating a substrate;
- Group IV: Claims 23 and 26, drawn to a binder and its utilization in adhering organic polymers to inorganic substrates; and
- Group V: Claim 25, drawn to a method of improving rheological properties.

In addition, if Group III is elected, the Examiner is also requiring an election of a single disclosed Species as follows:

- a) claims 18 and 20 are directed to a method of protecting buildings and their facades using a formulation containing a mixture of n-propylethoxysiloxane oligomers;
- b) claim 21 is directed to a method of treating textiles, leather, and cellulose using a formulation containing a mixture of n-propylethoxysiloxane oligomers;
- c) claim 22 is directed to a method of coating glass fibers using a formulation containing a mixture of n-propylethoxysiloxane oligomers; or
- d) claim 24 is directed to a method of modifying surface fillers with a mixture of n-propylethoxysiloxane oligomers, presumably for the purpose of preventing structuring in, or increasing the compatibility of the filler with, a polymer matrix to which the filler has been added.

Applicants elect, with traverse, Group I, Claims 1-14, 16, 27-35. With the election of Group I an Election of Species is not required.

Applicants note that the claims of Groups II-V directly depend from the claims of Group I, and as such it is improper to separate these claims.

In regard to Groups I and II, the Office has characterized the relationship between these two groups as "process of making and product made." Citing MPEP §806.05(f), the Office suggests the product as claimed can be made by another and materially different process. However, there is no evidence of record to show that the claimed products could be made as the Office has alleged. If, in fact, the claimed product can be made by the alleged processes, the Office has failed to show that the alleged processes are materially different from the claimed process. Accordingly, Applicants respectfully submit that the Restriction Requirement is unsustainable, and it should therefore be withdrawn.

In regard to Group I and Group III-V, the Office has characterized the relationship between these two groups as product and process of use. Citing MPEP §806.05(h), the

Office concludes that the product can be used in a myriad of materially different process. However, the claims of Group III-V are directly depend from the claims of Group I, and as such the product of Group I *is* used in the processes of Group III-V. Accordingly, Applicants respectfully submit that the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Withdrawal of the Restriction Requirement is respectfully requested.

The Office has characterized the inventions of Groups III, IV, and V as unrelated. Citing MPEP §806.04 and MPEP §808.01, the Office concludes that Groups III-V are unrelated because of the disparate effects that are to be conveyed by each method. However, the claims of Group III-V are directly depend from the claims of Group I, and as such these Groups are related by the inclusion of the oligomeric mixture of Group I. Accordingly, the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Accordingly, Applicants respectfully submit that the Restriction Requirement should be withdrawn.

Applicants traverse the Restriction Requirement on the grounds that the Office has not shown that a burden exists in searching all the claims of the present application.

Moreover, MPEP §803 states as follows:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on its merits, even though it includes claims to distinct or independent inventions.

Applicants submit that a search of all claims would not constitute a serious burden on the Office.

Additionally, MPEP §821.04 states:

...if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from

or otherwise include all the limitations of the allowable product claim will be rejoined.

Applicants respectfully submit that should the elected group be found allowable, non-elected process claims should be rejoined.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

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